

REMARKS

Claims 1-30 and 32-33 are pending in this application. Claims 31 and 34 were previously canceled. Claims 1, 16, and 20 are in independent form. Claims 2-15 depend from claim 1, claims 17-19 and 32-33 depend from claim 16, and claims 21-30 depend from claim 20. The claims have not been amended.

The Office Action in this matter was issued prior to the United States Supreme Court's decision in the case of KSR Int'l Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007) (the Supreme Court's slip opinion is available on-line at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>). In light of the KSR decision, Applicants wish to address various issues pertaining to a proper analysis under section 103.

When the Examiner issued the Office Action, establishing a *prima facie* case of obviousness required the Examiner to show with evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility. In re Fulton, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

As will be discussed below, the Examiner has failed to establish a *prima facie* case according to these standards. Applicants wish to point out that the Supreme Court's KSR decision did not reject use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis. Indeed, the Supreme Court characterized the analysis as "a helpful insight." KSR, slip op. at 14-15. Although the Supreme Court did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible analysis of an obviousness question. In the event that the Examiner chooses to pursue a different avenue for rejection, it should be noted that any new avenue would be new grounds for rejection not due to any action by Applicants.

Applicants further respectfully remind the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of

obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicants are entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

In the office action, the Examiner rejected the claims for the same reasons as presented in the prior office action, dated December 13, 2006. In particular, claims 1-21, 32, and 33 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of U.S. Patent No. 6,774,603 to Liao and U.S. Patent No. 5,744,934 to Wu. Claims 22-25 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of Liao, Wu and U.S. Patent No. 4,893,351 to McKee. And claims 26-30 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of Liao, Wu, and U.S. Patent No. 6,371,535 to Wei et al.

Applicants' representative has read the Examiner's Response to Arguments, and based upon the Examiner's Response, it appears that the Examiner is missing the point of the present invention. This is evident from the way that the Examiner has "combined" Liao and Wu. As stated in the specification, the present invention is directed to a "battery charging assembly 30 that includes an adapter 32 that provides for usage of the assembly in a number of different countries." (Spec. at page 5, lines 21-13; Pub. at ¶ 41). This is accomplished by providing different adapters that have different plug ends for use in different countries. (See description in Specification on page 5, line 30 to page 6, line 14; Pub. at ¶ 41). This aspect is inherent or expressly provided for in the claims, which have adapters that mate with a receptacle or socket on the battery charging unit. The adapters are connected to "a plug configured to mate with a style of electrical outlet."

Applicant recognizes that Wu and Liao can be combined in a manner different from the manner described in the prior response. That would be to take Fig. 8 of Liao and put the plug adapter 41 and orifice 11 of Wu onto the adapter plug 66 of Liao. When that is accomplished, the device of Liao maintains its remote location relative to the wall plug and has different adapter heads 41 for use in different countries. But this combination is different from the combination suggested by the Examiner and would not render the claims obvious.

In combining Liao and Wu, the Examiner states that "the input end (fig. 2, item 13) of Liao is modified to be a chamber with contacts (fig. 1, item 11) as taught by Wu. Furthermore, the plug of Liao (fig. 8, item 64) is modified as the plug of Wu (fig. 1, item 4) in order for the

plug to be inserted into the chamber.” This combination of Liao and Wu really makes no sense. If you replace item 64 of Liao with item 4 of Wu, you get an adjustable connection, but that connection would not allow for the charging unit of Liao to be used in different styles of electrical outlets. Moreover, if you replace the input end, item 13 of Liao, with the plug 4 of Wu, the power cord 30 is either completely omitted, such that the combined unit would not be positionable remotely from an outlet, or the power cord 30 would then be provided with a cumbersome connector 29 that would have to be designed to mate with different style plugs 4, as taught by Wu.

Most importantly, even if you combine Wu and Liao as suggested, the combined apparatus still does not have all the features claimed, namely:

- 1) a base wall for seating against a surface with a receptacle defined in the base wall ;
- 2) an adapter having a face with at least one electrical contact on the face; or
- 3) the adapter face facing the receptacle when installed.

All of these elements are in claim 1 and not present in the combination suggested by the Examiner. In order for a combination of prior art references to render a claim obvious, all the elements of the claim must be taught or suggested by the combination, which is not the case here.

Claim 16 is similar, except for the receptacle is referred to as a “socket.” In claim 16, the charging unit has:

- 1) a base wall for seating against a surface; and
- 2) a socket defined in the base wall, with a set of input assemblies having an adapter for seating in the socket, with the adapter forming part of the base wall when installed in the socket.

Neither of these features are present in the combined Liao and Wu references, no matter how you combine them, e.g., with applicants’ combinations or with the Examiner’s combination.

The same is true for claim 20, which has similar elements where a body member seats in a receptacle defined in a base wall of a charging unit. All of the above features are missing from the combination detailed by the Examiner. For these reasons, applicants submit that the Liao and Wu references, when combined, do not teach, suggest, or predict the combination taught by the pending claims.

Applicants respectfully request that the Examiner reconsider the pending rejections and issue a notice of allowance. No fees are believed to be due with the submission of this

Amendment. Should any fees be required, the Commissioner is authorized to charge such fees to deposit account No. 50-1432.

Respectfully submitted,



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Date: August 14, 2007